

[modified]

PTO/SB/21 (07-06)

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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

Application Number

09/258,132

Filing Date

26 February 1999

First Named Inventor

GOELET, Philip

Art Unit

1634

Examiner Name

MYERS, Carla J.

Attorney Docket Number

13017-3

ENCLOSURES (Check all that apply)

<input checked="" type="checkbox"/> Petition Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to TC
<input checked="" type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment/Reply	<input checked="" type="checkbox"/> Petition under 37 CFR 1.183*	<input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation	<input type="checkbox"/> Status Letter
<input checked="" type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Change of Correspondence Address	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	Statement of Substance of Interview
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Request for Refund	Receipt Acknowledgement
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> CD, Number of CD(s) _____	Postcard
<input type="checkbox"/> Reply to Missing Parts/Incomplete Application	<input type="checkbox"/> Landscape Table on CD	
<input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	Remarks	

*with Appendices A-C attached.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Kalow & Springut LLP		
Signature			
Printed name	J. David Ellett, Jr.		
Date	20 September 2006	Reg. No.	27,875

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature			
Typed or printed name	J. David Ellett, Jr.	Date	20 September 2006

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PETITION FEE Under 37 CFR 1.17(f), (g) & (h) TRANSMITTAL (Fees are subject to annual revision)	Application Number	09/258,132
	Filing Date	26 February 1999
	First Named Inventor	GOELET, Philip
	Art Unit	1634
	Examiner Name	MYERS, Carla J.
	Attorney Docket Number	13017-3

Send completed form to: Commissioner for Patents
P.O. Box 1450, Alexandria, VA 22313-1450

Enclosed is a petition filed under 37 CFR 1.183 that requires a processing fee (37 CFR 1.17(f), (g), or (h)). Payment of \$ 400 is enclosed.

This form should be included with the above-mentioned petition and faxed or mailed to the Office using the appropriate Mail Stop (e.g., Mail Stop Petition), if applicable. For transmittal of processing fees under 37 CFR 1.17(i), see form PTO/SB/17i.

Payment of Fees (small entity amounts are NOT available for the petition fees)

☒ The Commissioner is hereby authorized to charge the following fees to Deposit Account No. 11-0171:

☐ petition fee under 37 CFR 1.17(f), (g) or (h) ☒ any deficiency of fees and credit of any overpayments

Enclose a duplicative copy of this form for fee processing.

☒ Check in the amount of \$ 520 is enclosed.

☐ Payment by credit card (Form PTO-2038 or equivalent enclosed). Do not provide credit card information on this form.

Petition Fees under 37 CFR 1.17(f): Fee \$400 Fee Code 1462

For petitions filed under:

- § 1.36(a) - for revocation of a power of attorney by fewer than all applicants
- § 1.53(e) - to accord a filing date.
- § 1.57(a) - to accord a filing date.
- § 1.182 - for decision on a question not specifically provided for.
- § 1.183 - to suspend the rules.
- § 1.378(e) - for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent.
- § 1.741(b) - to accord a filing date to an application under § 1.740 for extension of a patent term.

Petition Fees under 37 CFR 1.17(g): Fee \$200 Fee Code 1463

For petitions filed under:

- § 1.12 - for access to an assignment record.
- § 1.14 - for access to an application.
- § 1.47 - for filing by other than all the inventors or a person not the inventor.
- § 1.59 - for expungement of information.
- § 1.103(a) - to suspend action in an application.
- § 1.136(b) - for review of a request for extension of time when the provisions of section 1.136(a) are not available.
- § 1.295 - for review of refusal to publish a statutory invention registration.
- § 1.296 - to withdraw a request for publication of a statutory invention registration filed on or after the date the notice of intent to publish issued.
- § 1.377 - for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent.
- § 1.550(c) - for patent owner requests for extension of time in *ex parte* reexamination proceedings.
- § 1.956 - for patent owner requests for extension of time in *inter partes* reexamination proceedings.
- § 5.12 - for expedited handling of a foreign filing license.
- § 5.15 - for changing the scope of a license.
- § 5.25 - for retroactive license.

Petition Fees under 37 CFR 1.17(h): Fee \$130 Fee Code 1464

For petitions filed under:

- § 1.19(g) - to request documents in a form other than that provided in this part.
- § 1.84 - for accepting color drawings or photographs.
- § 1.91 - for entry of a model or exhibit.
- § 1.102(d) - to make an application special.
- § 1.138(c) - to expressly abandon an application to avoid publication.
- § 1.313 - to withdraw an application from issue.
- § 1.314 - to defer issuance of a patent.

Signature
J. David Ellett, Jr.
 Typed or printed name

20 September 2006

Date

27,875

Registration No., if applicable

This collection of information is required by 37 CFR 1.17. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 5 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS: SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Free Patent Application of:

Applicants: GOELET, Philip, *et al.*

Application No.: 09/258,132

Filed: 26 February 1999

For: **“Nucleic Acid Typing by
Polymerase Extension of
Oligonucleotides Using
Terminator Mixtures”**

Office of the Deputy Commissioner
for Patent Examination Policy

Kalow & Springut LLP
488 Madison Avenue, 19th Floor
New York, New York 10022

20 September 2006

Mail Stop Petition
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

09/25/2006 HGE BREM1 00000014 09258132

01 FC:1462

400.00 OP

**PETITION UNDER 37 CFR 1.183
TO SUSPEND THE RULES**

SIR or MADAM:

In connection with the patent application identified above, the attorneys for the applicants hereby petition the United States Patent and Trademark Office under 37 CFR 1.183 to suspend rule 37 CFR 1.136(a)(1)(i) and enter a petition for a one-month extension of time under 37 CFR 1.136(a), attached as Appendix B, and a statement making of record the substance of a

Certificate of Mailing Under 37 CFR 1.8

I hereby declare that this Petition to Suspend the Rules with Appendices A- C attached are being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, Post Office Box 1450, Arlington Virginia 22313-1450, on 11/1/2011.

20 September 2006.
Date

J. David Ellett, Jr. (Reg. No. 27,875)

Applicants : GOELET, Philip, *et al.*
Application No.: 09/258,132
Filing Date : 26 February 1999
Page 2

telephonic interview held with the examiner in charge of the application, attached as Appendix C, notwithstanding an indication in an interview summary issued 20 July 2006 that a one-month period of time to file such a statement was non-extendable. The present petition is being submitted by mail with a certificate of mailing within two months of the date of the interview summary. It is submitted that the present petition is therefore timely under 37 CFR 1.181(d).

The facts on which the present petition is based are set out below.

On 19 May 2005 an Office Action was issued in connection with the subject application in which certain claims of the application were finally rejected. The final rejection was appealed in a notice of appeal timely submitted to the United States Patent and Trademark Office by mail on 18 November 2005 along with petition to extend the time through 19 November 2005, each accompanied by a certificate of first-class mailing. The appeal was dated 21 November 2005. A petition to extend the time to file an appeal brief in the appeal through 21 June 2006 was submitted to the United States Patent and Trademark Office by mail on 21 June 2006 along with a reply after final action and a request for continued examination (RCE) of the application, each accompanied by a certificate of first-class mailing. An information disclosure statement also accompanied the reply after final action and the request for continued examination.

On or about 28 June 2006, the undersigned attorney requested a telephone interview with Examiner Carla J. Myers, the examiner in charge of the subject application. The examiner courteously granted the request for an interview. The interview was scheduled for 18 July 2006 to give the examiner time to review the previously submitted reply after final action and information disclosure statement. The telephone interview was held as scheduled on 18 July 2006.

On 20 July 2006 Examiner Myers issued an interview summary which identified the claims discussed in the interview, indicated that no agreement had been reached with respect to the claims, and included comments by the examiner concerning the substance of the interview.

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Filing Date : 26 February 1999
Page 3

A copy of the interview summary of 20 July 2006 is attached to the present petition as Appendix A.

The interview summary of 20 July 2006 stated that the formal written reply to the last Office Action must include the substance of the interview. The interview summary of 20 July 2006 provided further that, if a reply to the last Office Action had already been filed, a statement of the substance of the interview had to be filed within the period of the longer of one month or thirty days from the date of the interview or the mailing date of the interview summary form, whichever was later. The period for filing the statement was stated to be non-extendable. In the present case, since a reply to the last Office Action had been filed prior to the interview of 18 July 2006, the one-month deadline for filing a statement of the substance of the interview would have been 20 August 2006.

Unfortunately, the undersigned attorney handling the subject application inadvertently did not take notice of the 20 August 2006 deadline for filing a statement of the substance of the interview until after the deadline had passed.

A new Office Action in connection with the subject application was issued on 5 September 2006. The Office Action of 5 September 2006 was designated a non-final action. The 5 September 2006 Office Action did not indicate that the subject application had fallen abandoned for failure to file a statement of the substance of the interview of 18 July 2006 by the 20 August 2006 deadline.

The undersigned attorney spoke with Examiner Myers by telephone on 11 September 2006 concerning whether, under the circumstances, it was necessary to petition to revive the subject application or if the deadline for filing a statement of the substance of the interview of 18 July 2006 could be extended. Examiner Myers noted that the new Office Action had been issued, that the one-month deadline was ordinarily meant to apply to situations in which no new Office Action was to be issued, and that filing the substance of the interview with the reply to the new Office Action would seem to be acceptable. Although the possibility of filing a

Applicants : GOELET, Philip, *et al.*
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Page 4

petition to suspend the rules was not discussed, the undersigned attorney indicated that, if the application was not revived by petition, the record of the case should somehow directly confirm that the application had not fallen abandoned.

The patent rule governing extensions of time, 37 CFR 1.136(a)(1), provides, in pertinent part, that:

If an applicant is required to reply within a nonstatutory or shortened statutory time period, applicant may extend the time period for reply up to the earlier of the expiration of any maximum set by statute or five months after the time period set for reply, if a petition for an extension of time and the fee set in § 1.17(a) are filed, unless:

- (i) Applicant is notified otherwise in an Office action.

In the present case, had no reply been filed to the last Office Action prior the issuance of the interview summary of 20 July 2006, the applicants under the terms of interview summary form would have been able to file the substance of the interview in a reply to the last Office Action and could have obtained under the terms of 37 CFR 1.136(a)(1) an extension of time to file such reply, including the substance of the interview, up to the maximum set by statute. Likewise, had the interview summary been issued with or after the latest Office Action of 5 September 2006, the applicants under the terms of interview summary form would have been able to file the substance of the interview in a reply to the latest Office Action and could have obtained an extension of time under the terms of 37 CFR 1.136(a)(1) to file such reply, including the substance of the interview, up to the maximum set by statute. However, because the interview summary of 20 July 2006 was issued after a reply had been filed to the last Office Action prior to the interview, but before issuance the latest Office Action after the interview, applicants had imposed by the terms of the interview summary form a minimally short one-month/thirty-day deadline to file a statement of the substance of the interview, which deadline, moreover, was stated to be non-extendable. Neither 37 CFR 1.133(b) nor 37 CFR 1.2, which provide that an applicant file a written statement of the substance of an interview, mandates imposition of a specific time period within which such a statement must be filed, let alone mandates imposition

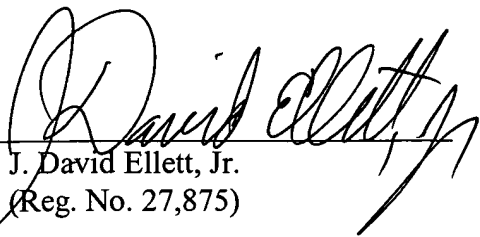
Applicants : GOELET, Philip, *et al.*
Application No.: 09/258,132
Filing Date : 26 February 1999
Page 5

of a shortened time period for filing such a statement which cannot be extended in accordance with the provisions of 37 CFR 1.136(a)(1). It is respectfully submitted that the potentially radical differences in time to file a statement of the substance of an interview and in eligibility for extensions of time under 37 CFR 1.136(a)(1) imposed by the wording of the interview summary form as a result of the relative timing of filing a reply to a pre-interview Office Action, issuance of an interview summary, and issuance of a post-interview Office Action can represent an element of arbitrariness and injustice and that, particularly in the circumstances of the present case in which a non-final Office Action was issued after the interview summary, it is appropriate under 37 CFR 1.183 to suspend the specific provision of 37 CFR 1.136(a)(1)(i) which appears to withhold otherwise-available extensions of time in cases in which a nonstatutory or shortened statutory time period for reply is designated non-extendable and allow an extension of time to file a statement of substance of the interview of 18 July 2006 notwithstanding the designation of the time period for filing such a statement in the interview summary as non-extendable.

For the reasons set forth above, it is submitted that favorable action on the present petition and entry of the accompanying petition for a one-month extension of time under 37 CFR 1.136(a) of Appendix B and statement of Appendix C making of record the substance of the 18 July 2006 telephonic interview with the examiner is warranted. Such favorable action is respectfully requested.

Respectfully submitted,

Attorneys for the Applicants

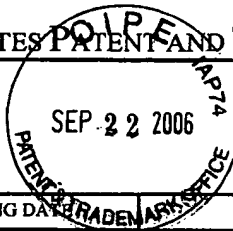
By 
J. David Ellett, Jr.
(Reg. No. 27,875)

Telephone: (212) 813-1600



UNITED STATES PATENT AND TRADEMARK OFFICE

13017-3



UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/258,132	02/26/1999	PHILIP GOELET	04990.0007.U	3407

7590

07/20/2006

David A. Kalow, Esq.
KALOW, SPRINGUT & BRESSLER, LLP
488 Madison Ave.
19th Floor
New York, NY 10022

EXAMINER

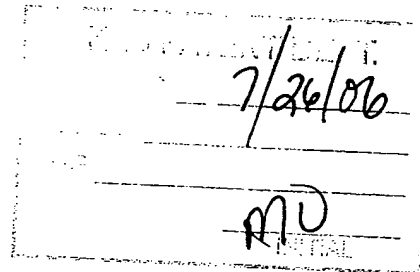
MYERS, CARLA J

ART UNIT PAPER NUMBER

1634

DATE MAILED: 07/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



Interview Summary

Application No.

09/258,132

Applicant(s)

GOELET ET AL.

Examiner

Carla Myers

Art Unit

1634

All participants (applicant, applicant's representative, PTO personnel):

(1) Carla Myers.

(3) _____.

(2) David Ellet.

(4) _____.

Date of Interview: 18 July 2006.Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]Exhibit shown or demonstration conducted: d) ☐ Yes e) ☐ No.

If Yes, brief description: _____.

Claim(s) discussed: 64 and 66-71.

Identification of prior art discussed: _____.

Agreement with respect to the claims f) ☐ was reached. g) ☒ was not reached. h) ☐ N/A.Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet.

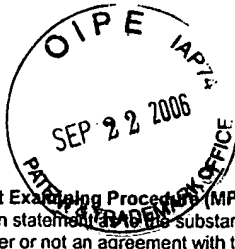
(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN A NON-EXTENDABLE PERIOD OF THE LONGER OF ONE MONTH OR THIRTY DAYS FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.


CARLA J. MYERS
PRIMARY EXAMINER

Examiner Note: You must sign this form unless it is an
Attachment to a signed Office action.

Examiner's signature, if required



Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement of the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Applicant's representative argued that Cohen teaches away from all methods which involve immobilization of nucleic acids. It was also argued that the method of Davis is similar to the methods cited by Cohen of Southern and Mundy in that each of these methods involves a step of detecting an immobilized nucleic acid. The examiner stated that the method of Davis is distinct from the methods of Southern and Mundy. In particular, the methods of Southern and Mundy each require irreversible immobilization of the target nucleic acid prior to probe hybridization, whereas the method of Davis requires solution hybridization of the target nucleic acid to a primer, the formation of a primer extension product, and the reversible immobilization of the primer extension product to a solid support. The examiner maintained that the comments regarding immobilization in the Cohen reference need to be considered in context of the full disclosure of this reference. That is, the Cohen reference only discusses immobilization of target nucleic acids prior to probe hybridization and thereby Cohen only teaches away only from immobilization methods which require the irreversible binding of a target nucleic acid prior to probe hybridization. There are no teachings in Cohen regarding reversible immobilization of nucleic acids after hybridization and primer extension. Thereby, Cohen is not considered to teach away from the method of Davis of reversibly immobilizing the primer extension product, which method allows for the advantages of simultaneously analyzing multiple sequences and improves the speed and sensitivity of detection.

Patent
128927.1



13017-3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Applicants: GOELET, Philip, *et al.*)
) Office of the Deputy Commissioner
Serial No.: 09/258,132) for Patent Examination Policy
)
Filed: 26 February 1999)
)
For: "Nucleic Acid Typing by Polymerase)
Extension of Oligonucleotides Using)
Terminator Mixtures")

Kalow & Springut LLP
488 Madison Avenue, 19th Floor
New York, New York 10022

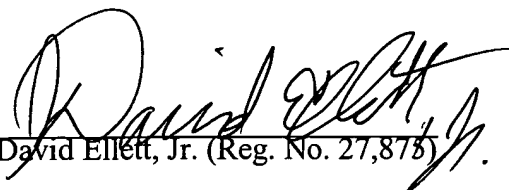
20 September 2006

Mail Stop Petition
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

Certificate of Mailing Under 37 CFR 1.8

I hereby declare that the attached Petition for Extension of Time Under 37 CFR 1.136(a) is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, Post Office Box 1450, Alexandria, VA 22313-1450, on

20 September 2006.
Date


J. David Ellett, Jr. (Reg. No. 27,875)

Patent
128998.1



13017-3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Applicants: GOELET, Philip, *et al.*)
) Office of the Deputy Commissioner
Serial No.: 09/258,132) for Patent Examination Policy
)
Filed: 26 February 1999)
)
For: "Nucleic Acid Typing by Polymerase)
Extension of Oligonucleotides Using)
Terminator Mixtures")

Kalow & Springut LLP
488 Madison Avenue, 19th Floor
New York, New York 10022

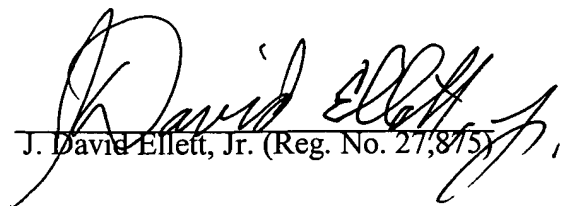
20 September 2006

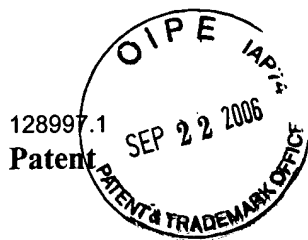
Mail Stop Petition
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

Certificate of Mailing Under 37 CFR 1.8

I hereby declare that the attached Statement of Substance of Interview pursuant to 37 CFR §§ 1.2 and 1.133(b) is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, Post Office Box 1450, Alexandria, VA 22313-1450, on

20 September 2006.
Date


J. David Ellett, Jr. (Reg. No. 27,875)



Attorney Docket No. 13017-3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	
)	
Applicants : GOELET, Philip <i>et al.</i>)	Examiner: MYERS, Carla J.
)	
Application No.: 09/258,132)	Group Art Unit: 1634
)	
Filing Date : 26 February 1999)	
)	
Title: "Nucleic Acid Typing By Polymerase)	
Extension of Oligonucleotides Using)	
Terminator Mixtures")	

Kalow & Springut LLP
488 Madison Avenue, 19th Floor
New York, New York 10022

20 September 2006

Commissioner for Patents
Post Office Box 1450
Alexandria, Virginia 22313-1450

STATEMENT OF SUBSTANCE OF INTERVIEW
PURSUANT TO 37 CFR §§ 1.2 and 1.133(b)

SIR or MADAM:

The purpose of the present statement is to make of record the substance of a telephonic interview courteously granted to the undersigned attorney by Examiner Carla J. Myers on 18 July 2006 with respect to the patent application identified above in accordance with the requirements of 37 CFR §§ 1.2 and 1.133(b).

Claims 64 and 66 through 71 of the subject application had been finally rejected in an Office Action dated 19 May 2005. Prior to the interview of 18 July 2006, a reply after final action and a request for continued examination (RCE) of the application had been timely filed with the Patent and Trademark Office with respect to the subject application, along with an

Applicants: GOELET, Philip *et al.*
Application No.: 09/258,132
Filing Date: 26 February 1999
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information disclosure statement. The examiner acknowledged in the interview that she had had an opportunity to review the reply after final action prior to the interview.

No exhibits were shown or demonstrations conducted in connection with the interview.

Rejected claims 64 and 66 through 71 inclusive were discussed in the interview, with the discussion generally focusing on independent claim 64.

Independent claim 64 had been rejected under 35 U.S.C. § 103(a) as unpatentable over French patent No. 2,650,840 to Cohen *et al.* (“the ‘840 French patent”) in view of International PCT published patent application WO 90/11372 in the name of the Davis *et al.* (“the ‘372 PCT published application”). The ‘840 French patent and the ‘372 PCT published application were discussed in the interview of 18 July 2006. Reference was also made generally to United States patent No. 4,656,127 to Mundy (“the Mundy ‘127 patent”) and to three citations identified in the information disclosure statement filed on 26 June 2006; namely, a publication by E. M. Southern in *Journal of Molecular Biology*, volume 98, pages 503 through 517 (1975) (“the Southern publication”); a publication by B. J. Conner *et al.* in *Proceedings of the National Academy of Sciences USA*, vol. 80, pages 278 through 283 (January 1983) (“the Conner *et al.* publication”); and an instruction manual for “Zeta-Probe[®] Blotting Membranes” published by Bio-Rad Laboratories of Hercules, California (“the Zeta-Probe manual”).

No proposed amendments to the subject application were discussed in the 18 July 2006 interview.

The thrust of the reasoning presented to the examiner on behalf of the applicants in the interview of 18 July 2006 is set out in detail in the reply after final action filed on 26 June 2006. In particular, it was contended that the ‘840 French patent taught against the hypothetical combination of the process of the French patent with the method of the ‘372 PCT published application proposed by the examiner. Specifically, the ‘840 French patent disclosed that a purported advantage of the process of the patent was that the process did not require immobilization of the nucleic acid on a membrane. The necessity to immobilize nucleic acid on

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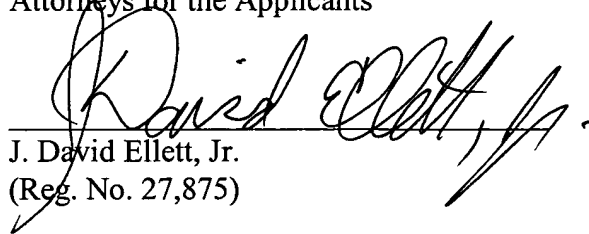
a membrane was specifically pointed out in the French patent to be a disadvantage of the previously-known Southern blot technique and the method of the Mundy '127 patent. It was contended that the method of the '372 PCT published application would have been recognized by persons of ordinary skill in the art as just such a technique involving immobilization of nucleic acid on a membrane from which the '840 French patent taught away. In this connection, it was pointed out generally that the Southern publication, the Conner *et al.* publication the Zeta-Probe manual clarified what persons of ordinary skill in the art would have understood was encompassed by the expression "Southern blot technique" referred to in the '840 French patent and clarified the nature of the nucleic-acid immobilization called for in the '372 PCT published application.

As noted in the examiner's interview summary of 20 July 2006, the examiner declined to agree to withdraw the rejection of the claims in the interview. The examiner's position with respect to points raised on behalf of the applicants at the interview is set out in the 20 July 2006 interview summary. No agreements with respect to any of the claims of the subject application were reached in the interview of 18 July 2006.

Respectfully submitted,

Attorneys for the Applicants

by:


J. David Ellett, Jr.
(Reg. No. 27,875)

Telephone No. (212) 813-1600